

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOMINARI ARAKI,
MASANORI NAKANO, KIHACHI SAKAIDA,
and KOUICHI KANNO

Appeal 2008-0208
Application 10/056,973
Technology Center 1700

Decided: November 29, 2007

Before CHARLES F. WARREN, THOMAS A. WALTZ, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

Applicants appeal to the Board from the decision of the Primary Examiner finally rejecting claims 10 through 51 in the Office Action mailed September 21, 2005. The Examiner refused to allow claims 10 through 12, 14 through 31, and 33 through 51 as subsequently amended, claims 13 and 33 having been cancelled. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2005).

We remand the application to the examiner for consideration and explanation of issues raised by the record. 37 C.F.R. §41.50(a)(1) (2007); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 6, August 2007).

Claim 10 illustrates Appellants' invention of an optical member comprising an easy-releasing protective member comprising a portion comprising an ink formulation, and is representative of the claims on appeal:

10. An optical member comprising:

an optical material comprising at least one of a polarizing plate, retardation plate and a brightness enhanced plate; and

an easy-releasing protective member, said easy-releasing protective member comprising a portion comprising an ink formulation and another portion without the ink formulation,

said easy-releasing protective member being provided on at least one side of front side and back side on the optical material,

wherein an optical transmittance of the portion comprising the ink formulation is no less than 90% and up to 100% of an optical transmittance of said portion without the ink information.

The Examiner relies upon the evidence in these references (Ans. 3):

Berler	US 3,763,356	Oct. 2, 1973
Mochizuki	US 4,812,034	Mar. 14, 1989
Koike	US 6,654,085 B1	Nov. 25, 2003

Appellants request review of the grounds of rejection under 35 U.S.C. § 103(a) advanced on appeal: claims 10 through 12, 14 through 21, 25 through 32, 34 through 40, and 44 through 51¹ as unpatentable over Koike in view of Berler; and claims 22 through 24 and 41 through 43 as unpatentable over Koike in view of Berler, further in view of Mochizuki. App. Br. 3; Ans. 3 and 5.

¹ The listing of claims reflects cancellation of claims 13 and 33.

The combination of Koike and Berler is basic to both grounds of rejection. There is no dispute that Koike would have disclosed to one of ordinary skill in this art an easy-releasing protective member on at least one side of the front side and back side of an optical material. Ans., e.g., 3-4; App. Br., e.g., 6; Reply Br., e.g., 3. Indeed, Appellants acknowledge that such an arrangement, wherein the protective member is physically modified to convey information, was known in the prior art. Spec. 1:11-21.

The dispute with respect to whether this person would have combined Koike and Berler, and thence modified Koike's protective member to contain any portion, however small, having any manner of ink information for identification as suggested by Berler, focuses on Berler's disclosure of imprinting, among other things, a "tape characterized as having substantial translucence," such as "yellow teletype tape," with a particular fluorescent ink formulation to form a "document" that can be read in one direction only upon exposure to ultraviolet light. Ans., e.g., 4 and 6-7; App. Br., e.g., 5-7; Reply Br., e.g., 4; *see* Berler, e.g., col. 1, ll. 4-9, col. 2, ll. 18-36, col. 3, ll. 15-48, and col. 5, ll. 8-13.

Subsequent to the entry of the Board of Patent Appeals and Interferences Docketing Notice, Appellants filed an Information Disclosure Statement (IDS) on October 25, 2007, submitting Japanese patent document JP 9-176586. The Abstract accompanying this document in the IDS identifies the subject matter therein as involving an optical protecting tape having at least a portion containing a fluorescent substance-containing ink conveying information.

It seems to us that if the Japanese patent document is admissible, it reasonably would be pertinent to the issue addressed by the Examiner by applying Berler.

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to consider the IDS, and if entered, obtain an authoritative translation of the Japanese patent document, and further consider the ground of rejection advanced on appeal in light of the authoritative translation and any other relevant prior art developed by the Examiner, with a view toward placing this application in condition for decision on appeal with respect to the issues presented.

This remand is made for the purpose of directing the examiner to further consider the grounds of rejection. Accordingly, if the examiner submits a supplemental answer to the Board in response to this remand, “appellant must within two months from the date of the supplemental examiner’s answer exercise one of” the two options set forth in 37 C.F.R. §41.50(a)(2) (2007), “in order to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding,” as provided in this rule.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

REMANDED

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